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09/393,473	09/10/1999	WAYNE COHEN	A32636-07270	2770

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EXAMINER

HSIEH, SHIH YUNG

ART UNIT	PAPER NUMBER
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2837

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/393,473

Filing Date: 9/10/1999

Appellant(s): Wayne Cohen

James J. Maune

For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/17/2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 13 and 14 do stand or fall together but does not provide reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

Claims 13 and 14 in Appendix A.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,808,215	Kralik et al.	9-1998
5,659,143	Isackson	8-1997
2,364,581	Zadek	12-1944

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kralik et al. in view of Isackson (5,659,143) and Zadek (2,364,581).

Kralik et al. disclose a maraca as stated in the office action of 7/19/2000. The difference between Kralik et al's maraca and claims 13 and 14 is that the claims recite using the maraca as

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an ornament for a key chain, said handle is fabricated of flexible material permitting resilient bending of said handle, said ornament having the overall shape of a miniature maraca having an overall length corresponding to the approximate width of a person's hand, and a bore sized for receiving a key ring or key chain member and is formed in the distal end of the handle of the maraca.

Isackson teaches using the maraca as an ornament for a key chain, and a bore is formed in the distal end of the handle of the maraca for receiving a key chain (col. 3, last line, and col. 4, lines 1-4, and "carried in a pocket or a purse" obviously means the size of said ornament having an overall length corresponding to the approximate width of a person's hand). Zadek teaches a rattle handle (18) made of flexible material (col. 2, line 10, and a flexible handle is obviously permitting resilient bending of said handle). It would have been obvious to a person having ordinary skill in the art to modify Kralik et al's ornament as taught by Isackson and Zadek to include the maraca as an ornament for a key chain with a handle fabricated of flexible material, and a bore is formed in the distal end of the handle of the maraca for the purpose of receiving a key chain.

(11) *Response to Argument*

The appellant argued that the Examiner incorrectly states the difference between the Kralik et al., Isackson and Zadek references and the article claimed in claims 13 and 14, and the major argument that Zadek does not disclose or suggest the flexible material permits resilient bending of the handle. The examiner disagrees.

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First, the difference between Kralik et al's maraca and the claims is the use of a maraca as an ornament for a key chain with a resilient handle, permitting resilient bending of said handle. This is clearly stated in the final rejection.

Second, all three references are directed to a maraca. Isackson teaches using the maraca as an ornament for a key chain with a bore formed at the distal end for receiving a key chain, and Zadek teaches a maraca with a flexible handle. A flexible handle is, by definition, bendable. See Webster's II New Riverside University Dictionary for the word "flexible" as capable of being bent or flexed. Therefore, the combination of the references reads on the claims.

In response of the appellant's argument that the Examiner committed error in disregarding the factual statement of the inventor's commercial success stated in the appellant's Secondary Considerations. The examiner disagrees with the appellant's statement that the examiner committed an error. The Examiner has considered the material contained in the appellant's Declaration and Exhibits and determined them inadequate to support a commercial success. The rationale for this determination is as follows:

(1) the commercial success of the invention

A mere statement of commercial success and the inclusion of a product catalog in the Declaration do not establish commercial success.

An appellant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. See MPEP 716.03.

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A catalog is considered as an advertisement which does not establish commercial success of market share. Further, gross sales figures do not show commercial success absent evidence as to market share. *Cable electric Products. Inc. v. Genmark, Inc.*, 770 F.d2 1015, 226 USPQ 881 (Fed. Cir. 1985). See MPEP 716.03(b).

In this case, the appellant fails to provide sufficient evidence to demonstrate commercial success.

(2) copying the invention by others

The appellant's statement of copying the invention by others as a secondary evidence of commercial success is not sufficient. More than the mere fact of copying is necessary to make this argument persuasive. See MPEP 716.06.


(3) facts concerning the invention

In response to appellant's argument that the inventor tried making a key chain following the teaching of the Kralik, et al. patent and resulted in failure, the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

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For the above reasons, it is believed that the rejections should be sustained.

Respectively submitted,


SHIH-YUNG HSIEH
PRIMARY EXAMINER

Conferees:

Arthur Grimley 

Robert Nappi 

Shih-yung Hsieh 